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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/675,509 | 09/30/2003 | John Y. Chen | 55 | 6339 |

7590 03/09/2006

Attn: John Y. Chen
Applied Elastomerics, Inc.
163 West Harris Avenue
South San Francisco, CA 94080

EXAMINER

LILLING, HERBERT J.

ART UNIT PAPER NUMBER

1651

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/675,509 | Applicant(s) CHEN, JOHN Y. | |
| | Examiner HERBERT J. LILLING | Art Unit 1651 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Bib Data Sheet</u> . |

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1. Receipt is acknowledged of the prior art information disclosure statement filed September 30, 2003.

2. Claims 1-9 are pending in this application.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim I, drawn to an inflatable gel cushion having one property having a range of gel rigidity, classified in numerous classes since there is no indication of the component or components.
- II. Claims 2-3, drawn to inflatable gel cushion made from a hydrogenated styrene/butadiene block copolymer and 300- 1,600 parts by weight of a plasticizing agent classified in class 280, subclass 728.1.
- III. Claim 4, drawn to inflatable gel cushion made from a hydrogenated copolymer(s) with 2-Me-1, 3 butadiene and 1,3 butadiene and 300- 1,600 parts by weight of a plasticizing agent classified in class 280, subclass 728.1.
- IV. Claim 5, drawn to inflatable gel cushion made from a hydrogenated isoprene/butadiene block copolymer having a specific viscosity range and 300- 1,600 parts by weight of a plasticizing agent classified in class 280, subclass 728.1.

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V. Claim 6, drawn to inflatable gel cushion made from a hydrogenated styrene block copolymer, which has essentially no properties, classified in class 280, subclass 728.1.

VI. Claims 7-8, drawn to inflatable gel cushion made from a hydrogenated styrene block copolymer which is a block copolymer of poly (styrene-ethylene-ethylene-propylene-styrene) which has essentially no properties, classified in class 280, subclass 728.1.

Note that Trademarks are present in these claims.

VII. Claim 9, drawn to drawn to inflatable gel cushion made from SEBS block copolymers, SBS, SBEBS, silicone elastomer and polyurethane elastomer which claim having no specific properties are classified in several classes which includes, 428, 280, 523, 524, numerous subclasses for the stock material.

4. Each of the above Inventions is considered to be separate and patentably distinct from each other having different structures and properties. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search required for one invention is not required for the other invention.

In addition, the search and examination for the multiple inventions in view of the different structures and properties, the search and examination would be extremely burdensome. Thus, the restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species for the composition to prepare the inflatable restrain gel cushion in a vehicular system:

- i. Claim 1 gel cushion having no properties for the compounds or compositions for the diaphragm.
- ii. Claims 2-3 gel cushion made from hydrogenated styrene/butadiene block copolymer.
- iii. Claim 4 made from a hydrogenated copolymer(s) with 2-Me-1, 3 butadiene and 1,3 butadiene and 300- 1,600 parts by weight of a plasticizing agent.
- iv. Claim 5 made from a hydrogenated isoprene/butadiene block copolymer having a specific viscosity range and 300- 1,600 parts by weight of a plasticizing agent.
- v. Claim 6 made from a hydrogenated styrene block copolymer, which has essentially no properties.
- vi. Claims 7-8 made from a hydrogenated styrene block copolymer, which is a block copolymer of poly (styrene-ethylene-ethylene-propylene-styrene), which has essentially no properties.
- vii. Claim 9 made from compound(s) having no specific properties
 - a. SEBS block copolymers;
 - b. SBS;
 - c. SBEBS;
 - d. Silicone elastomer;
 - e. polyurethane elastomer. Select one of a, b, c or d species.

6. The species are independent or distinct because the structures are separate and patentably distinct from each other.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

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The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

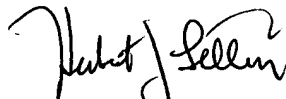
9. Applicant is requested to correct the data as noted on the Bib Sheet which indicates that the PTO records with a (*) are not consistent for the continuing data.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is 571-272-0918** and **Fax Number** is (703) 872-9306 or SPE Michael Wityshyn whose telephone number is 571-272-0926. Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.J.Lilling: HJL
(571) 272-0918
Art Unit 1651
March 08, 2006



Dr. Herbert J. Lilling
Primary Examiner
Group 1600 Art Unit 1651